

REMARKS

This is in response to the Office Action mailed January 10, 2005. Reconsideration and allowance of the subject application are respectfully requested.

The Examiner's withdrawal of the finality of the previous Office Action and re-opening of prosecution, in response to Applicant's Appeal Brief, are noted.

No amendments have been made to the subject application by the within Amendment.

In the Office Action, the Examiner has rejected all of the currently pending claims (i.e., claims 1-43) under 35 USC § 103(a) as being unpatentable over Ofek (U.S. Patent No. 5,901,327). It is respectfully submitted that this rejection is in error.

As the Examiner is well aware, in order to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. . . **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure** [emphasis added]. *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *Manual of Patent Examining Procedure* (MPEP), 8th Edition, August 2001, § 2143.

The teachings and deficiencies of Ofek vis-à-vis the claimed invention are set forth in detail in, *inter alia*, Applicant's Appeal Brief. Significantly, in the Office Action, the Examiner now acknowledges that Ofek fails to teach the use of a host bus adapter (HBA). Office Action, page 3. However, the Examiner asserts that one skilled in the art would have been motivated to selectively modify Ofek's disclosed arrangement to include an HBA "comprising the controller as taught by Ofek" because the resulting arrangement would eliminate "the need for transfer of data over a signal path, thereby providing faster and more reliable data transfer." Id.

In response, Applicant notes that Ofek neither discloses nor suggests any motivation to make the selective combination proffered by the Examiner, **much less** the specific alleged motivation proffered by the Examiner in the Office Action. Additionally, Ofek neither discloses nor suggests anything that would have engendered in one skilled in the art a reasonable expectation of success of the Examiner's proffered selective combination. The Examiner has failed to supply any prior art reference or personal affidavit that overcomes these deficiencies of Ofek. Therefore, as a matter of law and USPTO patent examination policy, the Examiner has failed to make a *prima facie* case of obviousness of the claims in view of Ofek.

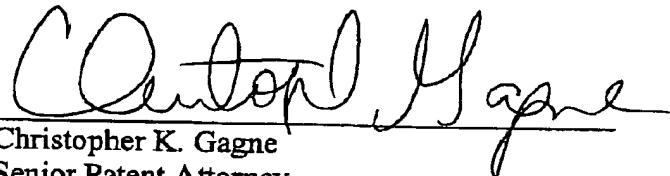
Additionally, as is discussed in detail in Applicant's Appeal Brief, specific combinations of limitations of the independent claims are nowhere disclosed or suggested in Ofek, and permit the inventions of these independent claims to achieve advantages that are not achieved by Ofek's disclosed system. For example, although these independent claims are not limited to the specific embodiments disclosed in the Specification, the Specification at page 23, lines 1 to 13 describes at least some of these advantages in the context of one of these embodiments. (See, e.g., Specification, page 23, lines 1 to 13).

Thus, inasmuch as the Examiner has failed to make a *prima facie* case of obviousness, and in view of the specific, advantageous combinations of limitations of the independent claims that are not disclosed or suggested in Ofek, it is respectfully submitted that Ofek does not render obvious the claims of the subject application. Thus, it is respectfully submitted that the Examiner's rejection of claims 1-43 under 35 USC § 103(a) as being rendered obvious by Ofek has been overcome.

In the event that the Examiner deems personal contact desirable in further disposition of this case, the Examiner is invited to call the undersigned attorney at 480-715-4055.

Please charge any shortages and credit any overcharges to Deposit Account number 02-2666.

Respectfully submitted,



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